THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 65

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte WOLFGAN JAKOBI, BENNO BESLER,
WERNER A. KLUGE-PALETTA,
SUSANN FRIEDRICH, PETER JAUCHEN,
and BODO SZONN

Appeal No. 2003-0459
Application 08/727,328[1]

HEARD: JULY 15, 2003

Before PAK, KRATZ, and POTEATE, Administrative Patent Judges.

PAK, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal under 35 U.S.C. § 134 from the examiner's final rejection of claims 15, 16 and 21 through 23. Claims 18 through 20, the remaining claims in the above-identified reissue application, have been withdrawn from consideration by the examiner as being drawn to a nonelected invention.

[1] Application for patent filed October 8, 1996.

APPEALED SUBJECT MATTER

Claim 23 is representative of the subject matter on appeal and reads as follows:

23. A method for the production of rolls of relatively narrow double sided adhesive tape for securing sections of carpet, which tape is easily transversely tearable by hand, comprising the steps of:

1) unwinding a wide band of biaxially stretched double sided adhesive tape having a polypropylene backing having an upper and a lower surface and two longitudinal side edges, an adhesive layer on said upper and lower surfaces and a release paper on a least one of the adhesive-coated surfaces off an unwind shaft;

2) passing the unwinding band between said unwind shaft and a wind-up shaft over the surface of a cutting back-up roll;

3) cutting through the wide band of double faced adhesive tape to form narrow tapes by means of at least one cutter and cutting shaft;

the cutter having a cutting edge of a profile such that it imparts to the cut tape in at least one side edge a series of continuous tooth notches of about 0.3 to 6 mm in height; and

4) collecting the narrow tapes on the wind-up shaft, whereby the resulting narrow tapes can be torn by hand transversely.

PRIOR ART

As evidence of obviousness, the examiner relies on the following prior art references:

Aycock	2,400,527	May 21, 1946
Heinzelman et al. (Heinzelman)	4,447,482	May 8, 1984
Darbo	4,851,064	Jul. 25, 1989
Johnson & Johnson (Johnson) (Published British Patent Specification)	1,188,344	Apr. 15, 1970

REJECTION

The appealed claims stand rejected as follows:

1) Claims 15, 16 and 21 through 23 under 35 U.S.C. § 103 as unpatentable over the combined disclosures of Johnson and Aycock; and

2) Claims 15, 16 and 21 through 23 under 35 U.S.C. § 103 as unpatentable over the combined disclosures of Johnson, Aycock, Heinzelman and/or Darbo.

OPINION

We have carefully reviewed the claims, specification and applied prior art, including all of the arguments and evidence advanced by both the examiner and appellants in support of their respective positions. This review has led us to conclude that the examiner's Section 103 rejections are not well founded. Accordingly, we will not sustain the examiner's Section 103 rejections for essentially those reasons set forth in the Brief. We add the following primarily for emphasis.

As recognized by the examiner, modifying a known double-stick, biaxially stretched polypropylene carpet tape, as taught by Johnson and Aycock, would not result in the claimed invention. See the Answer, pages 3 and 4. The examiner not only acknowledges that neither Johnson nor Aycock teaches the claimed series of continuous toothed notches of about 0.3 to 6 mm in height, but also is unsure whether Johnson and Aycock are directed to tapes which can be torn by hand transversely.[2] See the Answer, pages 4 and 6. We also note that Johnson, the only

[2] *In re Warner*, 379 F.2d 1011, 1017, 154 USPQ 173, 177-78 (CCPA 1967), *cert. denied*, 389 U.S. 1057 (1968), *reh'g denied*, 390 U.S. 1000 (1968) (the examiner has the initial burden of supplying sufficient factual basis to support a *prima facie* case of obviousness under 35 U.S.C. § 103).

applied reference directed to a biaxially stretched polypropylene tape, not only teaches much smaller notches than that claimed, but also teaches notches useful for a purpose different from that claimed (i.e., notches that can be used with a conventional serrated cutting edge or equivalent cutting edge[3]).

Under these circumstances, we are constrained to agree with the appellants that the examiner has not demonstrates that the optimization of prior art notches for the prior art purpose would result in the claimed double-stick, biaxially stretched polypropylene carpet tape having a series of continuous toothed notches having a particular height. *See In re Shetty*, 566 F.2d 81, 195 USPQ 753 (CCPA 1977); *see also In re Sebek*, 465 F.2d 904, 907, 175 USPQ 93, 95 (CCPA 1972) ("Where, as here, the prior art disclosure suggests the outer limits of the range of suitable values, and that the optimum resides within that range, and where there are indications elsewhere that in fact the optimum should be sought within that range, the determination of optimum values outside that range may not be obvious."). One of ordinary skill in the art interested in using micro-notches of the type useful for Johnson's purpose would not have been led to make the claimed double-stick, biaxially stretched polypropylene carpet tape.

Moreover, the examiner's further reliance on Darbo and Heinzelman does not remedy the deficiencies indicated above. We initially observe that neither Darbo nor Heinzelman is directed to a biaxially stretched polypropylene tape, much less the claimed double-stick biaxially stretched polypropylene carpet tape. We also observe that Darbo and Heinzelman not only do

[3] During the hearing dated July 15, 2003, the examiner acknowledged that the "conventional serrated cutting edge or dispensing edge" disclosed in Johnson is a serrated cutting edge or equivalent cutting edge.

not teach notch "height" as a result effective variable, but also do not use their notches for the same purpose disclosed by Johnson.

Under these circumstances, it cannot be said that the examiner has identified sufficient suggestion or motivation in the applied prior art references to alter the height of notches and/or the design of a double-stick, biaxially stretched polypropylene carpet tape in the manner contradictory to the teachings of Johnson. *In re Lee*, 277 F.3d 1338, 1343, 61 USPQ2d 1430, 1433 (Fed. Cir. 2002)("'The factual inquiry whether to combine references must be thorough and searching.'... It must be based on objective evidence of record. This precedent has been reinforced in myriad decisions, and cannot be dispensed with."); *W.L. Gore & Assoc. v. Garlock*, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983)("To imbue one of ordinary skill in the art with knowledge of the invention in suit, when no prior art reference or references of record convey or suggest that knowledge, is to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher.").

Thus, on this record, we are constrained to agree with the appellants that the examiner has not established a *prima facie* case of obviousness regarding the claimed subject matter.

Accordingly, we reverse the examiner's decision rejecting the claims on appeal under 35 U.S.C. § 103.

REVERSED

CHUNG K. PAK Administrative Patent Judge	)	
PETER F. KRATZ Administrative Patent Judge	)	BOARD OF PATENT APPEALS AND INTERFERENCES
LINDA R. POTEATE Administrative Patent Judge	)	

CP/dal

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